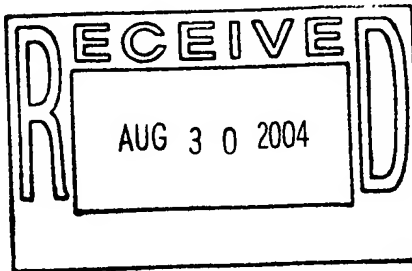




UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Pepper Hamilton LLP
One Mellon Center, 50th Floor
500 Grant Street
Pittsburgh PA 15219



Paper No. 5

COPY MAILED

AUG 27 2004

OFFICE OF PETITIONS

In re Application of
Donoho, et al.
Application No. 60/453,112
Filed: March 7, 2003
Attorney Docket No. 124256.400

:
:
:
:
:

ON PETITION

This is a decision on the petition filed July 21, 2004, requesting that the application be accorded a filing date of March 7, 2003, instead of the presently accorded filing date of May 12, 2003.

The application was filed on March 7, 2003. However, on April 30, 2003, The Office of Initial Patent Examination mailed a "Notice of Omitted Item(s) in a Provisional Application" (Notice) stating that the application had been accorded a filing date of March 7, 2003, and advising applicants that Figure 11, as described in the specification, appeared to have been omitted.

In response, on May 12, 2003 applicants filed Figure 11.

The Office of Initial Patent Examination processed Figure 11 and accorded the application a new filing date of May 12, 2003.

In the instant petition, petitioners argue that a complete application was filed on March 7, 2003 and that Figure 11 was not required for the understanding of the invention.

The mailing of a "Notice of Omitted Items in a Provisional Application" permits applicants to either: (1) promptly establish prior receipt in the PTO of the item at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) accept the application as filed. Applicants asserting that a missing item was in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit.

In this case, petitioners neither asserted that the missing figure was actually filed on March 7, 2003 with the original application papers, nor accepted the application as filed without the

missing figure. Instead, applicants merely submitted Figure 11 on May 12, 2003.

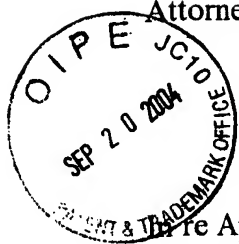
Due to petitioners' unorthodox response to the Notice, Figure 11 was processed. However, it is not permissible to amend a provisional application. 37 CFR 1.53(c). The application papers are those that were present in the Office on March 7, 2003. Therefore, the petition is **granted**. The application will be reprocessed **without** Figure 11 and the original filing date of March 7, 2003 will be reinstated. The petition fee will not be refunded, since the petition was necessitated by petitioners' error.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of **March 7, 2003**. Figure 11 is not considered part of the original application papers and will not be processed. The Office of Initial Patent Examination will address the petition to add inventors, filed March 31, 2003.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.



E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Applications of
Steven Kirk DONOHO, et al.

1. Utility Application
Serial No.: 10/686,462
Filed October 15, 2003

Art Unit: 3621
Examiner: not yet assigned

2. Provisional Application
Serial No.: 60/453,112
Filed March 7, 2003

Title: METHOD AND SYSTEM FOR THE PROTECTION OF BROKER AND INVESTOR
RELATIONSHIPS, ACCOUNTS AND TRANSACTIONS

**PETITION UNDER 37 C.F.R. 1.53(e)(2) TO CORRECT
FILING DATE OF PROVISIONAL APPLICATION
AND PRIORITY DATE OF RELATED UTILITY APPLICATION**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The undersigned hereby petitions the U.S. Patent and Trademark Office (USPTO) to accord (1) a filing date of March 7, 2003 to the above-referenced Provisional Application, and (2) a priority date of March 7, 2003 to the above-referenced Utility Application which claims priority to the Provisional Application.

With respect to the Provisional Application, the applicants filed a complete application on March 7, 2003. On April 30, 2003, the USPTO: (i) issued a filing receipt awarding a filing date of March 7, 2003 to the Provisional Application; and (ii) mailed a Notice

of Omitted Items requesting the submission of FIG. 11. On May 8, 2003, applicants filed a Response to Notice of Omitted Items which included a copy of FIG. 11, as requested by the USPTO. A copy of the Response to Notice of Omitted Items is attached hereto as Exhibit A. Subsequently, the USPTO accorded a new filing date of May 12, 2003 to the Provisional Application.

Applicants respectfully ask the USPTO to correct the filing date of the Provisional Application to the March 7, 2003 date set forth in the original filing receipt. FIG. 11 was not necessary under 35 U.S.C. 113 (first sentence) to establish a filing date, as FIG. 11 was not necessary for the reader to understand the nature of the subject matter to be patented. Rather, FIG. 11 merely illustrated exemplary elements of a general purpose computer system, and the elements of FIG. 11 and their interrelationships were described in detail in paragraph [0071] of the specification (page 33). The invention is not directed toward, and the related Utility Application does not claim, a general purpose computer system. Accordingly, FIG. 11 was not necessary under 35 U.S.C. 113 (first sentence) to establish the filing date of the Provisional application, and the original filing date of March 7, 2003 should apply to the Provisional Application. *See* MPEP 506.02 and 601.01(f).

Because the filing date of the Provisional Application should be March 7, 2003, applicants also request that the USPTO award a priority date of March 7, 2003 to the Utility Application, in accordance with the priority claim set forth by the applicants in the Utility Application as filed.

The required petition fee of \$130.00 under 1.17(h) is attached. In the event that additional fees are required or a credit is due, the USPTO is hereby authorized to debit or credit Deposit Account 50-0436.

Respectfully submitted,

PEPPER HAMILTON LLP



James M. Singer
Registration No. 45,111

Date: July 19, 2004
Pepper Hamilton LLP
500 Grant Street
One Mellon Center, 50th Floor
Pittsburgh, PA 15219
phone: (412) 454-5023
facsimile: (412) 281-0717